

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL C. SMITH

Appeal No. 1998-2612
Application 08/478,289

ON BRIEF

Before HAIRSTON, JERRY SMITH and LALL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 13, 16 and 17. Claims 1-11 have been cancelled. Claims 12, 14 and 15 stand withdrawn from consideration as being directed to a non-elected invention. An amendment after final rejection was filed on October 27, 1997 but was denied entry by the examiner.

The disclosed invention pertains to an apparatus for patching an outboard accessory device into a signal path of a multi-channel music amplifier. More particularly, an effect-mix variable device is coupled between send and receive terminals which are optionally coupled to the outboard accessory device. The effect-mix variable device is controllable by a user to combine affected signal received from the outboard accessory device with unaffected signal received from the send terminal.

Representative claim 13 is reproduced as follows:

13. An apparatus for patching an outboard accessory device into a signal path of a multi-channel amplifier, the apparatus comprising:

a plurality of variable attenuators each coupled to a particular channel in the multi-channel amplifier for controlling a channel signal amplitude;

a common effect-send terminal alternately coupled to one of the plurality of variable attenuators for receiving an output signal from the multi-channel amplifier, the common effect-send terminal optionally coupled to an input of an outboard accessory device;

a common effect-receive terminal optionally coupled to an output of the outboard accessory device for receiving an outboard output signal;

an effect-mix variable device which is electrically coupled in parallel with the common effect send and receive terminals and which is controllable by a user to combine a first user-selectable amount of signal directly from the common effect send terminal with a second user-selectable amount of signal directly from the common effect receive terminal to form a mixed signal; and

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a variably controllable amplifier means coupled to the effect-mix variable device for receiving the mixed signal and delivering an amplified output signal to an output terminal.

The examiner relies on the following references:

Moog	4,180,707	Dec. 25, 1979
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The admitted prior art disclosed by appellant.

Claims 13, 16 and 17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers the admitted prior art in view of Moog.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 13, 16 and 17. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of

the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived

by appellant [see 37 CFR § 1.192(a)].

With respect to claim 13, the examiner finds that the admitted prior art teaches the claimed invention except for an effect-mix variable device electrically coupled in parallel with the common effect send and receive terminals, wherein the effect-mix variable device is controllable by a user to provide an effect output signal. The examiner cites Moog as teaching a

distortion sound effects circuit with its input coupled to the clean output, and the output distortion circuit is proportionally mixed with the clean output. The examiner finds that it would have been obvious to the artisan to incorporate the effect-mix variable device of Moog into the admitted prior art system [answer, pages 3-4].

Appellant argues that there is no teaching or suggestion to include the mixing circuitry of Moog into the admitted prior art because the admitted prior art already includes the mixing circuitry for blending affected signal with unaffected signal to allow a user to precisely select to what degree the outboard accessory device affects the signal. Appellant asserts that the addition of mixing circuitry to the admitted prior art would be superfluous and redundant [brief, pages 5-7].

The examiner responds that the proposed modification of the admitted prior art is to only incorporate the mixing circuitry as taught by Moog, not the whole outboard accessory device as disclosed in Moog so that there would be no redundant mixing circuitry after the modification [answer, page 6]. Appellant reiterates that the addition of mixing circuitry to the admitted prior art is still redundant and superfluous [reply brief].

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We will not sustain the examiner's rejection of claim 13. We agree with appellant that there is no reason for the artisan to add the circuitry of Moog, even if only the mixer, to the admitted prior art disclosed in Figure 1 of the application. As noted by appellant, the admitted prior art circuitry has already performed all the desired mixing. The only basis for plugging the Moog mixer between terminals 12 and 13 of the admitted prior art comes from an improper attempt to reconstruct appellant's claimed invention in hindsight. Therefore, we will not sustain the rejection as formulated by the examiner.

Since claim 16 depends from claim 13, we also do not sustain the examiner's rejection of claim 16. We note for the record, however, that appellant's separate argument for the patentability of claim 16 is also correct. The examiner's finding that Moog is capable of being configured so that the first and second user-selectable amounts are inversely related does not support the obviousness of the claimed recitation that the first and second user-selectable amounts are necessarily inversely related. Moog does not teach or suggest that the claimed relationship be achieved.

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With respect to independent claim 17, we also do not sustain the examiner's rejection of claim 17 for reasons discussed above with respect to claim 13. We also agree with appellant's separate argument that the proposed modification of the admitted prior art with the circuitry of Moog would still not provide a fixed resistance between the common effect send and receive terminals nor would elements 34 and 38 of Moog be electrically coupled in parallel with the common effect send and receive terminals as recited in claim 17.

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In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 13, 16 and 17 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
PARSHOTAM S. LALL)	
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